

REMARKS

The Office Action mailed March 18, 2005, has been carefully reviewed and the following remarks have been made in consequence thereof.

Claims 1-3, and 20-22 are pending in this application. Claims 1-3, and 20-22 stand rejected.

The objection to Claim 20 is respectfully traversed. Claim 20 has been amended to include a period at the end of the claim. Accordingly, Applicant requests that the objection to Claim 20 be withdrawn.

The rejection of Claims 1, 21, and 22 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Claim 1 has been amended to recite "a second strap." In addition, Claim 1 has been amended to more clearly recite that the second portion has a thickness that is greater than the thickness of the first and third portions. Claims 21 and 22 depend, directly or indirectly, from independent Claim 1. Accordingly, Applicant respectfully requests the Section 112 rejections of Claims 1, 21, and 22 be withdrawn.

The rejection of Claims 1-3 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Wahlert (U.S. Patent No. 622,739) is respectfully traversed.

Wahlert describes a pipe clamp for attaching a pipe in close proximity to a plane surface, such as the bottom of a car. The pipe clamp includes a yoke or cap section A and a bed or seat section B. Yoke section A is generally U-shaped, and bed section B includes a raised seat-section 5 and a pair of laterally-projecting ears 6. Each ear includes an opening. Seat-section 5 is formed with a first pair of opposing walls and a second pair of opposing walls connected

together to form a rectangular frame that defines a cavity. Each wall with the first pair of walls is substantially rectangular-shaped. Each wall within the second pair of walls includes an arcuate outer edge that is curved to conform to an inside arch of the yoke section A. Accordingly, when bed section B is coupled with yoke section A, the second pair of opposing walls within bed section B and yoke section A form a substantially circular opening.

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Wahlert as suggested in the office action, with respect to either its structure or material. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, and not in the applicant's disclosure. As explained by the Federal Circuit, "the test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000), MPEP 2143. Moreover, the Federal Circuit has determined that:

[i]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). In the present case, neither a suggestion nor motivation to modify the Wahlert device, nor any reasonable expectation of success has been shown.

Moreover, in the office action, it is suggested that it would be obvious to bend the second strap clamp around the tube. However, in Wahlert, if the second strap clamp A is bent around the pipe, the seat section B would not fit together with yoke section A to form a substantially circular opening sized to receive the pipe therein. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP § 2143. Furthermore, since there is no teaching nor suggestion in the cited art for the asserted modification, and since the modification renders the prior art invention unsatisfactory for its intended purpose, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, this is impermissible, and for this reason alone, Applicant requests that the Section 103(a) rejection of Claims 1-3 and 20-22 be withdrawn.

Moreover, Applicant submits that it would not have been obvious modify Wahlert to obtain the claimed recitations of Claim 1. Obviousness cannot be established by merely suggesting that it would be obvious to one of ordinary skill in the art to have selected an alternative design choice. Rather, each allegation of what would have been an obvious matter of design choice must always be supported by citation to some reference work recognized as standard in the pertinent art, and the Applicant given an opportunity to challenge that correctness

of the assertion or the reputé of the cited reference. Applicant has not been provided with the citation to any reference supporting the combination made in the rejection.

Claim 1 recites a method of securing a tube to an engine housing using a clamping assembly, wherein the method comprises: “securing a first strap clamp to the engine housing wherein the first strap clamp includes...a first portion, a second portion, and a third portion...wherein the second portion extends between the first and third portions, and has an upper surface, a lower surface, and a substantially constant thickness extending therebetween...and securing the tube to the first strap clamp with a second strap clamp, such that at least a portion of the tube is retained between the first and second clamps.”

Wahlert does not describe nor suggest a method for securing a tube to an engine housing using a strap clamp which includes a unitary elongate body that has a first portion, a second portion, and a third portion, wherein the second portion extends between the first and third portions, and has a substantially constant thickness extending between the first and third portions. Rather, in contrast, Wahlert describes a pipe clamp including a bed section formed of four walls arranged in a frame, wherein a thickness across each arcuate wall is variable. For the reasons set forth above, Claim 1 is submitted to be patentable over Wahlert.

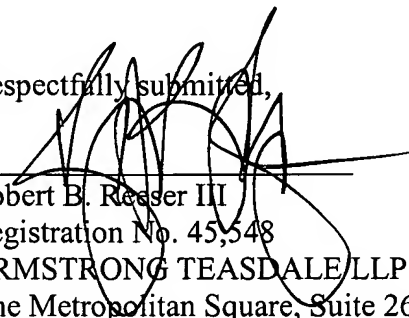
Claims 2, 3, and 20-22 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2, 3, and 20-22 are considered in combination with the recitations of Claim 1, Applicant submits that Claims 2, 3, and 20-22 are likewise patentable over Wahlert.

For at least the reasons set forth above, Applicant respectfully requests the Section 103 rejection of Claims 1-3 and 20-22 be withdrawn.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.



Respectfully submitted,


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